07-13-01

AF/3651

Walker & Jocke

a legal professional association

Ralph E. Jocke
Patent
&
Trademark Law

July 11, 2001

Director of Technology Center 3600
Commissioner for Patents
Washington, D.C. 20231

Re: **Application Serial No.:** **09/384,650**
Appellants: **James A. Michael, et al.**
Title: **Method For Dispensing Medical Items**
Docket No.: **D-1079 Div**

Sir:

Please find enclosed a Petition pursuant to 37 C.F.R. § 1.181 for Withdrawal of Holding of Noncompliance with 37 C.F.R. § 1.192(c) for filing in the above case.

No fee is deemed required. However, the Commissioner is authorized to charge any necessary fee associated with the filing of the Petition, and any other fee due, to Deposit Account 04-1077.

Very truly yours,

Ralph E. Jocke
Reg. No. 31,029

CERTIFICATE OF MAILING BY EXPRESS MAIL

I hereby certify that this document and the documents indicated as enclosed herewith are being deposited with the U.S. Postal Service as Express Mail Post Office to addressee in an envelope addressed to Director of Technology Center 3600, Commissioner for Patents, Washington, D.C. 20231 this 11th day of July 2001.

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Ralph E. Jocke

330 • 721 • 0000 MEDINA | 330 • 225 • 1669 CLEVELAND | 330 • 722 • 6446 FACSIMILE | rej@walkerandjocke.com E-MAIL

231 South Broadway, Medina, Ohio U.S.A. 44256-2601

#14
7-19-01

D-1079 Div

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

In re Application of: **James A. Michael, et al.**	)	
	)	
Serial No.: **09/384,650**	)	Art Unit 3651
	)	
Filed: **August 27, 1999**	)	Patent Examiner:
	)	Michael E. Butler
Title: **Method For Dispensing Medical Items**	)	

Director of Technology Center 3600
Commissioner for Patents
Washington, D.C. 20231

Sir:

Appellants received a Notification of defective appeal brief, including a holding of noncompliance with 37 C.F.R. § 1.192(c), dated July 5, 2001. If a request for reconsideration is first required, then this petition should be considered as such.

Petition For Withdrawal of Holding of Defective Appeal Brief

Appellants respectfully petition against the holding of defective appeal brief, including a holding of a noncompliance with 37 C.F.R. § 1.192(c), dated July 5, 2001. Appellants respectfully petition for the withdrawal of the holding of defective appeal brief. Appellants' Brief was asserted by the Examiner to be defective because it exceeded a brief size limit. That is, the

Brief was held to exceed an alleged 30-page, 14,000 words, or 1,300 lines limitation. The Appellants maintain that this is not a legal basis for holding the Brief defective and in noncompliance with 37 C.F.R. § 1.192(c).

The Notification of defective appeal brief dated July 5, 2001 ("Notification") asserts that the PTO is an administrative agency, and because of the Administrative Procedures Act unless a statute on point or an agency promulgated rule on point exists, then the Federal Rules of Evidence and Federal Rules of Appellate Procedure apply.

That erroneous assertion was purportedly based on 5 U.S.C. § 559, which is part of the Administrative Procedures Act. However, that statute does not state that the Federal Rules of Evidence and Appellate Procedure apply to Federal agencies if there is not a specific agency rule on the matter. A copy of 5 U.S.C. § 559 is attached hereto. The specific part of the Statute misquoted by the Examiner, states "Except as otherwise required by law, requirements or privileges relating to evidence or procedure apply equally to agencies and persons."

The Statute provides that Due Process applies equally to agencies and people. It does not imply that the Federal Rules of Appellate Procedure, let alone the brief page limit in such Rules, applies to appeals to the Board of Patent Appeals and Interferences.

The few cases that have mentioned the cited Statute (or its predecessor, 5 U.S.C.A. § 1011) have considered issues related to Due Process, such as whether certain documents had to be made available before an administrative hearing was held, what steps needed to be followed before a new Indian reservation was created and what standard should be used to evaluate the agency's decisions. Sperry and Hutchinson Co. v. F.T.C., 256 F. Supp. 136, 143; U.S. v. Libby, McNeil & Libby, 107 F. Supp. 697, 703. Similarly, in Dickinson v. Zurko, No. 98-377, 527 U.S.

150 (1999) the courts were concerned with issues of Due Process, not the Federal Rules of Evidence or the Federal Rules of Appellate Procedure.

Zurko is an appeal of a U.S. Patent Office decision. Id. However the decision in Zurko does not in any way hold or imply that the Federal Rules of Appellate Procedure are applicable to appeals before the Board of Patent Appeals and Interferences. The United States Supreme Court only decided the standard of review for a patent appeal in the Federal Circuit Court of Appeals. Id. The Examiner incorrectly cited the case in attempting to make an argument for which there is absolutely no legal support.

Rule 1 of the Federal Rules of Appellate Procedure states, "These rules govern procedure in the United States courts of appeals." It does not say that the Federal Rules of Appellate Procedure apply to the agencies of the U.S. Government.

Contrary to the Examiner's assertion the courts have stated that absent an express agency rule the Federal Rules of Evidence do not apply to administrative proceedings. U.S. Steel Mining Co., Inc. v. Director, Office of Workers' Compensation Programs, 187 F. 3d 384, 388 (4th Cir. 1999) and Peabody Coal Co. v. Director, Office of Workers' Compensation Programs, 165 F. 3d 1126, 1128-1129 (7th Cir. 1999). Similarly the Federal Rules of Appellate Procedure also do not apply to administrative agencies, absent an express agency rule making such rules applicable. The U.S. Patent and Trademark Office has no such rule.

The invalid conclusion of the Examiner is that unless there is a statute or agency promulgated rule on point, then the Federal Rules of Evidence and the Federal Rules of Appellate Procedure are applicable to administrative agencies. Appellants have shown that conclusion to be unsupported and courts have reached the exact opposite conclusion. However

even if the Examiner's position were correct, there are rules promulgated by the Patent and Trademark Office that apply specifically to appeals before the Board of Appeals and Interferences. Because specific agency rules have been promulgated which have different provisions, the Federal Rules of Appellate Procedure do not apply to Appellants' Brief.

The Notification admits that "There is no statutory limit within Titles 35 or 5 of the Code or Title 37 of the Rules on brief size before the Board of Patent Appeals and Interferences." The Appellants agree with the Examiner that there is no limit within the statutes, rules, or Office procedures concerning the length of a brief presented to the Board. Furthermore, it is respectfully submitted that an agency (PTO) promulgated rule directly on point already exists. MPEP § 1206 at page 1200-9 (Rev. 1. Feb. 2000) clearly states:

> 37 CFR 1.192(c) merely specifies the minimum requirements for a brief, and does not prohibit the inclusion of any other material which an appellant may consider necessary or desirable, for example, a list of references, table of contents, table of cases, etc. A brief is in compliance with 37 CFR 1.192(c) as long as it includes items (1) to (9) in the order set forth (with the appendix, item (9), at the end).

Appellants' Brief includes items (1) to (9). Thus, Appellants' Brief is in compliance with 37 C.F.R. § 1.192(c) and is not defective.

Further evidence that Appellants' Brief is in compliance with the PTO Rules may be obtained from the Notification itself. Nowhere in the Notification is it indicated that Appellants' Brief does not contain the items (1) to (9). Thus, the Office itself by inference admits that Appellants' Brief contains items (1) to (9) and is in compliance with 37 C.F.R. § 1.192(c).

Furthermore, 37 C.F.R. § 1.192 requires that Appellants "must set forth the authorities and arguments on which appellant will rely to maintain the appeal" and "the brief shall contain the following items" (1) to (9). Attention is also directed to 37 C.F.R. § 1.111 and 37 C.F.R. § 1.113. It is noted that 37 C.F.R. § 1.111 requires a "reply to every ground of objection and rejection." To set a limit on the size of a brief would be in direct conflict with the requirements imposed on Appellants by the statutes and rules, including 37 C.F.R. § 1.192(c)(8) which requires Appellants to explain the errors in each rejection presented. In cases like the present appeal, thirty (30) pages are not sufficient to comply with the express requirements of 37 C.F.R. § 1.192 for all the pending claims and grounds for rejection.

Furthermore, an Appellants' representative spoke with Mr. Craig Feinberg (Administrator for Patent Appeals and Interferences) from the Board on April 17, 2001 concerning any rule on brief sizes. Mr. Feinberg assured Appellants' representative that he was unaware of any limitation on the size of a brief. The Board of Appeals and Interferences has received numerous briefs from Appellants' representative and others that exceed thirty (30) pages without objection.

Furthermore, it is respectfully submitted that the Notification is not in compliance with the procedural rules of the Office. MPEP § 1206 at page 1200-10 (Rev. 1, Feb. 2000) states that "The examiner may use the form paragraphs set forth below or form PTOL-462, 'Notification of Non-Compliance with 37 CFR 1.192(c),' to notify appellant that the appeal brief is defective" and further states that "Form paragraphs 12.08-12.13, 12.16, 12.17, and 12.69-12.78, or Form PTOL-462, 'Notification of Non-Compliance with 37 CFR 1.192(c),' may be used concerning the appeal brief." The Examiner has used neither the guidance of Office-approved form paragraphs nor form PTOL-462. The Manual of Patent Examining Procedure (MPEP) does not provide for any

other exceptions. That is, the MPEP does not provide any basis for the requirements in the Notification. The Examiner, at best, has used a modified version of sole concluding form paragraph 12.78 in the "period for response" section of the Notification.

The Notification's lack of Office-approved form paragraphs or form PTOL-462 is taken as further evidence that the Examiner's actions do not comply with the approved patent examining procedures of the Office. Thus, the Notification does not meet the procedural rules of the Office. Hence, it is further submitted that the holding of defective appeal brief should be withdrawn on this basis.

Furthermore, since the Notification is not in compliance with the Office's own rules and procedures, the Notification is defective.

Unless the Examiner can produce some legal authority with respect to limiting brief size, then it appears that the Examiner has clearly exceeded his bounds of authority. Not only did the Examiner attempt to create his own new rules, but he further attempted to judge Appellants' Brief based on these self-created new rules. Nevertheless, Appellants have shown the Examiner's actions to be in clear error.

The Notification also violates Appellants' Constitutional rights. There is no limit on the number of claims which can be filed. Also, there is no limit on the number of different rejections that can be applied by the Office. Limiting the size of Appellants' Brief would prevent Appellants from being able to fully respond to all rejections in an (unlimited in size) Office Action. This would constitute a denial of Due Process.

Additionally, unless the Office is holding all appeal briefs to a specific (lower) size limit (which it is not), then the Office's action against Appellants constitutes action which is arbitrary and capricious, and a violation of Appellants' Due Process and Equal Protection rights.

The holding of defective appeal brief should be withdrawn for the reasons presented herein. Furthermore, the holding of defective appeal brief should be withdrawn on the basis that (1) the Brief is already in full compliance with 37 C.F.R. § 1.192(c), and (2) the Notification is defective by not being in compliance with the Office's own rules and procedures. Appellants respectfully request that their petition be granted.

Appellants note that the Notification does not mention any other alleged defects in the brief. Hence, Appellants conclude that the Examiner did not find any other defective brief issues during his complete review of Appellants' entire Brief in accordance with his examining duties. Therefore, Appellants also respectfully request that the Examiner be instructed to write an Examiner's Answer so that this application may properly proceed without further delay on its way to the Board.

The undersigned will be happy to discuss any aspect of the Application by telephone at the Office's convenience.

Respectfully submitted,

Ralph E. Jocke Reg. No. 31,029
WALKER & JOCKE
231 South Broadway
Medina, Ohio 44256
(330) 721-0000

US Code as of: 01/23/00

Sec. 559. Effect on other laws; effect of subsequent statute

This subchapter, chapter 7, and sections 1305, 3105, 3344, 4301(2)(E), 5372, and 7521 of this title, and the provisions of section 5335(a)(B) of this title that relate to administrative law judges, do not limit or repeal additional requirements imposed by statute or otherwise recognized by law. Except as otherwise required by law, requirements or privileges relating to evidence or procedure apply equally to agencies and persons. Each agency is granted the authority necessary to comply with the requirements of this subchapter through the issuance of rules or otherwise. Subsequent statute may not be held to supersede or modify this subchapter, chapter 7, sections 1305, 3105, 3344, 4301(2)(E), 5372, or 7521 of this title, or the provisions of section 5335(a)(B) of this title that relate to administrative law judges, except to the extent that it does so expressly.

UNITED STATES DEPARTMENT OF COMMERCE
Patent and Trademark Office
Address: COMMISSIONER OF PATENTS AND TRADEMARKS
Washington, D.C. 20231

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.
09/384,550	08/27/99	MICHAEL J	D-1079-DIV

RALPH E JOCKE
231 SOUTH BROADWAY
MEDINA OH 44256

PM82/0705

EXAMINER	
BUTLER,M	
ART UNIT	**PAPER NUMBER**
3651	13

DATE MAILED: 07/05/01

Please find below and/or attached an Office communication concerning this application or proceeding.

Commissioner of Patents and Trademarks

Defective Appeal Brief

Application No.	Applicant(s)	
09/384,650	MICHAEL ET AL.	
Examiner	**Art Unit**	
Butler	3651	

--The MAILING DATE of this communication appears on the cover sheet with the correspondence address--

The Appeal Brief filed on 4/24/01 is defective because:

The brief exceeds the 30 page safe harbor brief size limit of Rule 32 (7)(A) of The Federal Rules of Appellate Procedure, FED. R. APP. P. 32 (7)(A); 28 U.S.C. Appendix, as invoked by the Administrative Procedures Act, 5 U.S.C. § 559. Applicant has failed to avail himself of the alternate 1300 line or 14,000 word brief volume limits of Rule 32 (B or C).

Defective Appeal Brief

1. The appellant's 123 page "Brief" is defective for exceeding the principal brief size limit without receiving special leave from the Board to file an oversized "brief." The Federal Rules (of Appellate Procedure) provide a safe harbor limit for principal briefs of 30 pages. FED. R. APP. P. 32 (7)(A); 28 U.S.C. Appendix. Alternately, appellants may certify brief volume to a maximum of 14,000 words or 1300 lines with a monofaced type. FED. R. APP. P. 32 (7)(B & C); 28 U.S.C. Appendix. As a further alternative, the party may obtain special leave from the adjudicator. FED. R. APP. P. 32, Judicial Advisory Committee Annotations on Rule 32.

The Administrative Procedures Act proscribes that unless a statute on point or an agency promulgated rule on point exists, the [Federal] Rules of Evidence and Procedure apply, 5 U.S.C. § 559. The United States Patent and Trademark Office is an administrative agency within the context of the Administrative Procedures Act. Dickenson vs. Zurko, 50 USPQ2d 1930, 1933; 527 U.S. 150 (1999). In his majority opinion, Justice Breyer held that § 559 generates uniform procedural standards among the agencies. Dickenson vs. Zurko at 1933; Id. at 1935.

By way of example, a rule on point expressly superceding § 559 is the express page limit for briefs filed before the Trademark Trial and Appeal Board. 37 CFR § 2.128(b). Statutes superceding § 559 include other portions of the Administrative Procedures Act such as the standard of review expressly proscribed in 5 U.S.C. § 706 wherein the § 706 standard of review superceded implementation of Rule 52(A) as triggered via § 559. Dickenson vs. Zurko at 1932. There is no statutory limit within Titles 35 or 5 of the Code or Title 37 of the Rules on brief size before the Board of Patent Appeals and Interferences. As there is no express rule or statute on point limiting brief size, the 30 page safe harbor limit of Rule 32 applies unless a party is granted permission via special leave from the Board upon exercise of the Board's discretionary authority or unless party elects to certify volume as expressed in word count or line count.

When a party generates an oversized brief, he unduly burdens the adjudicator with excessive analysis and obscures the focus of the issues they need analyze and decide, thereby making the task of the adjudicator (in this instance, the Board) more difficult. As such, a party needs obtain permission from the adjudicator when burdening it with such an extra workload. Since applicant failed to obtain leave from the Board of Patent Appeals and Interferences for the filing of an oversized brief, applicant's 123 page brief is defective.

As noted in the included annotated sections, the Judicial Advisory Committee wrote Rule 32(7) with its 14,000 word/1300 line limitations, toward a goal of proximating Rule 32 in word content with the 50 page limit of old Rule 28(G) of which it was replacing. Rule 28(G) was written at a time when briefs were generated on typewriters.

Since the circuit courts have adopted assorted harsh penalties for exceeding volume content-inclusive of appeal dismissal, attorney sanctions, and non-consideration of the brief content exceeding the page limit-the examiner includes as a courtesy to applicant the article warning that briefs certified with MS Word® may give erroneous word counts if the factory default options are not properly deselected-an action held to be inexcusable attorney misrepresentation.

Conclusion

2. Appellant is required to comply with provisions of 37 CFR 1.192(c) and Rule 32. To avoid dismissal of the appeal, Appellant must comply within the longest of any of the following TIME PERIODS: (1) ONE MONTH or THIRTY DAYS, whichever is longer, from the mailing of this communication; (2) within the time period for reply to the action from which appeal has been taken; or (3) within two months from the date of the notice of appeal under 37 CFR 1.191. Extensions of these time periods may be granted under 37 CFR 1.136..

Attachment(s):

- ☒ Notice of References or Authority Cited, PTO-892
- ☐ Interview Summary, PTO-413
- ☐ Other:

Michael E. Barkla

DONALD P. WALSH
SUPERVISORY PATENT EXAMINER
TECHNOLOGY CENTER 3600